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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,978	01/03/2001	Wayne R. Lumpkin	AVID.13-3	1708

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EXAMINER

KIM, CHONG HWA

ART UNIT

PAPER NUMBER

3682

DATE MAILED: 07/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/753,978

Applicant(s)

LUMPKIN, WAYNE R.

Examiner

Chong H. Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,6 and 8-10 is/are pending in the application.
- 4a) Of the above claim(s) 6 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,8 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

The Examiner acknowledges the Applicant's Amendment filed Jan 21, 2003 in response to the Office action made on Oct 8, 2002. It is also acknowledged that the Office action made on Apr 2, 2003 in response to the Amendment filed Jan 21, 2003 had been erroneously mailed with a duplicate Office action made on Oct 8, 2002. Thus, the following Office action is fully responsive to the Amendment filed Jan 21, 2003.

Election/Restrictions

1. Claims 6 and 9 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species of Group 3B, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 15.

Claims 6 and 9 are withdrawn since the applicant had admitted in the Remark section of the Amendment that the limitations as recited in claims 6 and 9 are shown in Fig. 3B and not in Fig. 3A.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Matsuo, U.S. Patent 6,349,614 B1.

Matsuo shows, in Figs. 1-12, a bicycle cable guide system for maintaining tension in a straight portion of a flexible cable extending between a cable actuated bicycle component and a cable actuator selectively applying tension to the flexible cable, the cable guide system comprising;

a straight length of axially and radially rigid tubing 654 (see further discussion below in the Response to Argument paragraphs) having first and second ends and an inner diameter greater than an outer diameter of the flexible cable 650 receiving the straight portion of flexible cable;

a first axially fixed connector (as shown in Fig. 12) operatively associated with the first end of the rigid tubing;

a second axially fixed connector (as shown in Fig. 10) operatively associated with the second end of the rigid tubing; and

wherein the first axially fixed connector comprises a first length of flexible housing 674 receiving the flexible cable and a ferrule 630 between the first end of the housing and the first length of flexible housing.

4. Claims 5 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Matsuo, U.S. Patent 6,349,614 B1.

Matsuo shows, in Figs. 1-12, a bicycle cable guide system for maintaining tension in a straight portion of a flexible cable extending between a cable actuated bicycle component and a

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cable actuator selectively applying tension to the flexible cable, the cable guide system comprising;

a first length of flexible housing 674 having a select outer diameter and an inner diameter greater than the diameter of the cable 650;

a straight length of axially and radially rigid tubing 654 having an inner diameter greater than the diameter of the flexible cable;

a ferrule 630 joining an end of the first length of flexible housing to a first end of the axially and radially rigid tubing (as shown in Fig. 12); and

wherein the axially and radially rigid tubing has an outer diameter substantially the same as the outer diameter of the axially rigid and radially flexible housing.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuo.

Matsuo shows, as discussed above in the rejection of claim 5, the bicycle cable guide system comprising the first length of flexible housing and the first ferrule connecting the flexible housing and the one end of the rigid tubing; wherein the flexible housing has an axial length that does not radially buckle under application of tension to the flexible cable under a normal range

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of operating tensions applied to the cable to actuate the cable actuated component, but fails to show the cable actuated bicycle component being a cable actuated disc brake caliper.

It would have been obvious to apply the cable actuated device of Matsuo on the cable actuated disc brake caliper, since such a modification would have involved a mere application of present invention on an existing device. The selection of known device based on its suitability for the intended use is generally recognized as being within the level of ordinary skill in the art. *In re Leshin*, 125 USPQ 416. (Note: the Applicant is reminded to cancel claim 8 since the applicant's attorney had confirmed that no other parts of the present invention would be claimed except the cable guiding system.)

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1, 2, 5, 8, and 10 are rejected under the judicially created doctrine of double patenting over claims 1-8 of U. S. Patent No. 6,439,077 B2 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

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The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: the rigid tubing having two ends, connectors, two flexible housings, two ferrules joining the flexible housings to the ends of the rigid tubing.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Response to Arguments

9. In response to the applicant's argument that the tubing of Matsuo is actually a "flexible outer housing" for a Bowden cable rather than being a rigid tubing as recited in claim 1, it is understood by the Examiner that the, so called, "a straight length of axially and radially rigid tubing" recited in claim 1 refers to the element 348 shown in Fig. 3C which is the sectional view of Fig. 3A. The specification, as originally filed, on page 15, lines 11-20, appears to suggest that the element 348 has "sufficient rigidity that it will not radially buckle about its lengthwise axis upon application of tension within the normal range of operating tensions applied to the cable 40 which runs within the tube 348." Now, the key words in describing what really means by "axially and radially rigid" is "not radially buckle...upon application of tension within the normal range of operating tensions". If the Examiner is permitted to utilize the applicant's own lexicography, certainly the tubing 654 of Matsuo is axially and radially rigid enough that would

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“not radially buckle...upon application of tension within the normal range of operating tensions” applied to the cable 650.

10. In response to the applicant’s argument that the double patenting rejection should be withdrawn since US Patent No. 6,439,077 claims completely different subject matter, it is the Examiner’s position that the claim subject matter of US Patent No. 6,439,077 is a bicycle cable guide system. A cable feed as recited in claims 1-8 is not any different from the bicycle cable guide system as recited in the present claims. It appears that the claim languages in claims 1-8 of US Patent No. 6,439,077 are broad enough to interpret to be a cable guide system that includes all the limitations as set forth in claims 1, 2, 5, 8, and 10. Furthermore, US Patent No. 6,439,077 does not claim a cable feed “consisting of” but rather “comprising”.

11. In response to the applicant’s argument that the double patenting issue is of no practical consequence, it is suggested that the applicant review the 1202 OG 112 (Official Gazette RE – Patent and Trademark Office Practice and Procedure) for further discussion as to why double patenting issues are relevant in the area of common ownership.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chong H. Kim whose telephone number is (703) 305-0922. The examiner can normally be reached on Monday - Friday; 9:00 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Bucci can be reached on (703) 308-3668. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

chk
July 1, 2003


CHONG H. KIM
PRIMARY EXAMINER